

REMARKS

Claims 31 and 34-59 constitute the pending claims in the present application. Claims 32 and 33 have been cancelled. Claims 44-59 are currently added. Claims 31, 32, 42, and 43 currently stand rejected under §102(e) as being anticipated by U.S. 6,053,935 to Brenneman et al. ("the '935 patent"). Claims 33-43 currently stand rejected under §103(a) as being unpatentable over the '935 patent in view of U.S. 5,725,541 to Anspach, III et al. ("the '541 patent"). Independent claims 31, 42, and 43 are amended to include the limitations of claims 32 and 33. Claims 34 and 36-41 are amended to correct matters of form.

The Amended Claims Patentably Distinguish Over the '935 Patent

The '935 patent, in Figs. 13-22, cited by the Examiner, shows a bone anchor and an insertion device. As noted by the Examiner, the '935 patent does not teach a bone anchor having "at least two cutting edges extending along the head that come together to form a pointed tip at the narrow end," the limitation of claims 33. Applicants have amended independent claims 31, 42, and 43 to include this limitation of claim 33. More specifically, amended claims 31, 42, and 43 now recite "a bone anchor releasably engaged to the bone anchor mount and having a generally cone-shaped head including a wide end, a narrow end, and at least two cutting edges extending along the head that come together to form a pointed tip at the narrow end."

Since Applicants have amended claims 31, 42, and 43 to include the limitation of originally filed claim 33, Applicants respectfully submit that amended claim 1 also patentably distinguishes over the '935 patent. Accordingly, Applicants respectfully request that the Examiner pass amended claims 31, 42, and 43 to allowance. Since claims 34, 36-41, and 44-59 variously depend from claims 31, 42, and 43, and recite further limitations thereon, Applicants respectfully request that the Examiner also pass these claims to allowance.

The '935 Patent is Disqualified as Prior Art Under §103(a) Due to Common Ownership

Claims 33-41 stand rejected as being obvious over the '935 patent in view of the '541 patent. The '935 patent is currently assigned to Boston Scientific Corporation ("BSC"). The present application is assigned to Scimed Life Systems, Inc. ("Scimed"), a wholly owned subsidiary of BSC. Therefore, Applicants respectfully submit that the present application and the '935 patent, at the time the invention of the current application was made, were commonly

owned by, or subject to an obligation of assignment to, BSC. As the present application was filed after November 29, 1999 and is commonly owned by BSC along with the '935 patent, the '935 patent may not be cited under 35 U.S.C. 103(a) as a reference against the present application.

The '541 patent discloses a bone anchor having three triangular sides and sharp edges where the sides meet. ('541 patent, col. 5, ll. 3-5.) The '541 patent does not teach or suggest the bone anchor systems including "a hook-shaped shaft" as recited in claims 31, 42, and 43. Accordingly, Applicants respectfully submit that amended claims 31, 42, and 43 are patentable over the cited art and request that the Examiner pass amended claims 31, 42, and 43 to allowance. Since claims 34, 36-41, and 44-59 variously depend from claims 31, 42, and 43, and recite further limitations thereon, Applicants respectfully request that the Examiner also pass these claims to allowance.

Form PTO-892

Applicants note that the Notice of References Cited (form PTO-892) was not attached to the Office Action as indicated. During a telephone call on October 19, 2004, the Examiner stated she did not have the Notice of References Cited and was aware of citing only two patents: Brenneman et al. (U.S. Patent No. 6,052,935) and Anspach, III et al. (U.S. Patent No. 5,725,541).

New Claims 44-59

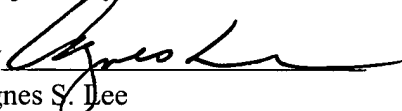
Claims 44-59 are currently added and are disclosed at least in Figs. 1-6 and on page 3, ll. 2-7 and 16-20, and page 6, line 17 – page 7, line 2. Applicants submit no new matter is added by the new claims.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that the pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 18-1945, under Order No. MIY-P02-002 from which the undersigned is authorized to draw.

Dated: December 21, 2004

Respectfully submitted,

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